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09/506,288	02/17/2000	Jin-Su Park	P51671RE	7560

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Robert E. Bushnell and Law Firm
1522 K Street, N.W. Suite 300
Washington, DC 20005-1202

EXAMINER

ISSING, GREGORY C

ART UNIT	PAPER NUMBER
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3662

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/506,288

Applicant(s)

PARK, JIN-SU

Examiner

Gregory C. Issing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Prosecution is re-opened in the instant application in view of the newly cited prior art and new grounds of rejection.

Election/Restrictions

2. Reissue claim 20 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 20 is directed to a process that is distinct from the apparatus claims of the original reissue claims of the patent since the process may be practiced by another materially different apparatus such as a device that does not require any mixer, or rather the process may be practiced by a parent evaluating the box/case of a video tape to see its rating, prior to inserting the tape into a VCR the parent signaling to a child that the video is not appropriate, and upon telling the child it is not appropriate, barring the transmission of the video content by removing the tape from the vicinity of the VCR, the VCR having a conventional standby mode and playback mode of operation. Additionally, it is distinct from any of the method claims since the method claims do not require any subjective evaluation to generate a code. Moreover, it is not seen where in the original specification such subjective evaluation is disclosed in a sufficient manner to meet the requirements of 35 USC 112 for someone skilled in the art to make and/or use such, particularly in light of the failure of the applicant to provide an explanation of the support in the disclosure for changes made to the claims.

3. According to 37 CFR 1.176,

37 CFR 1.176. Examination of reissue.

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

- 4.

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Since no disclaimer was filed in the reissue, the subject matter of the original patent claims will be held to be constructively elected. Accordingly, claim 20 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 1-19, 21-43 and 59 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-43 of copending Application No. 10/337,364. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Defective Amendment

7. The claims/amendments do not conform to the requirements as set forth in 37 CFF 1.173.

8. The amendments are incomplete since according to 37 CFR 1.173(c) there is no explanation of the support in the disclosure of the patent for the changes made to the claims according to 37 CFR 1.173(c). An amendment of the reissue application made at the time of filing of the reissue application must be made in accordance with 37 CFR 1.173(b)-(e) and (g); see MPEP § 1453. Thus, as required by 37 CFR 1.173(c), an amendment of the claims made at the time of filing of a reissue application must include a separate paper setting forth the status of all claims (i.e., pending or canceled), and an explanation of the support in the disclosure of the patent for the changes made to the claims. As the applicant has not provided this explanation in the prosecution of this application, such is now required. Applicant is required to include in the response an explanation of the support in the disclosure of the patent for the changes made to the claims in this reissue application.

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9. The amendment to claim 5 is not clear since the preamble removes "cassette" and adds "tape"; however, in lines 11, 12, 16, 19, the language "cassette" remains, and thus lacks a proper antecedent basis.

10. The amendment to Claim 7, lines 4-5 differs from the patented claim being copied/amended since the language ", and remaining in said system power standby mode of operation" is missing.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7, 9-19, 27-43, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rew (5,033,085 filed 6/1988) in view of Inagaki et al (4,896,354 filed 10/1985).

13. Rew discloses a method and system for controlling video (as displayed on Braun tube 67) and audio (as provided by speaker 66) of a television set having a standby mode of operation (via the fact that a remote control receiver (3) is powered during standby to be responsive to a remote control unit (2) for subsequent powering up of the video system at turn-on).

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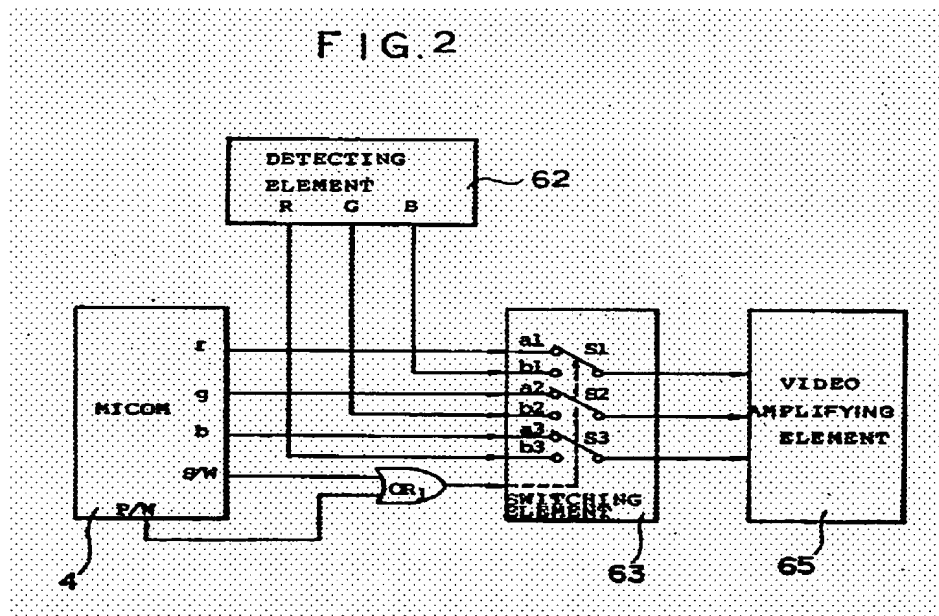
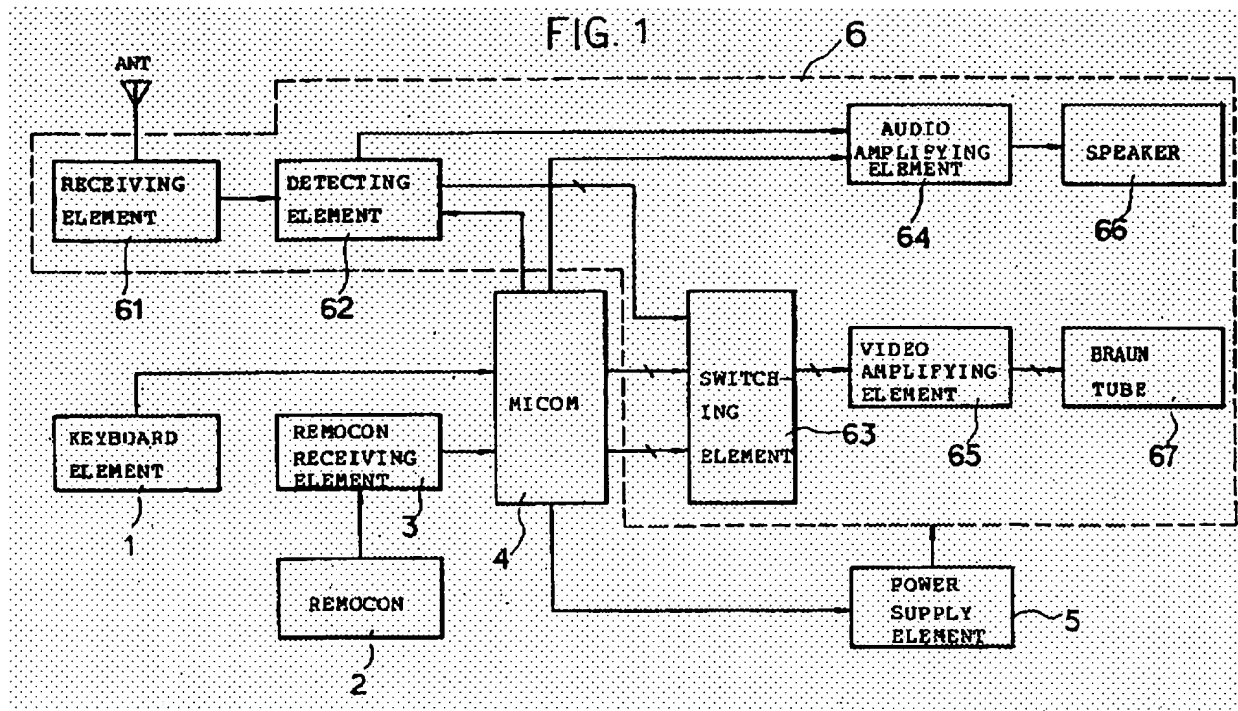


FIG. 1 is shown above including a microcomputer MICOM (4) responding to input signals selectively input from a keyboard (1) or a remote control receiver (3) for controlling the video images (output path via 63, 65) through the generation of a control output that controls the switching element (63). A receiving element (61) and detecting element (62) receive the video program signal and process

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a first video signal (RGB from detecting element (62) of Figure 2)) as well as a first audio signal that is provided to the audio amplifying means (64). The MICOM also includes an On Screen Character Generator circuit for outputting character data (via the rgb outputs of MICOM (4) of Figure 2). A switching element (63) is responsive to the detected video signals (RGB), the On Screen Character Generator circuit signals (rgb), and a control signal (S/W, P/W, OR₁) from the MICOM to selectively mute the video signals by preventing the video signal from being output to the video amplifying means (65). Additionally, the MICOM (4) provides a control signal to the audio amplifying element to mute the audio signal (col 3, lines 17-20, e.g). Rew operates such that during a power standby mode, a power key signal input is entered by the keyboard/remote controller (3:67 – 4:3). This power key input meets the scope of the claimed "lock key" or "lock key data". Subsequent to the power key input, one of two programs is run (Fig. 3A). The first program corresponds to a condition in which no locking code has already been entered into the system, enabling anyone with access of the power button to watch the display in a conventional manner, as in any conventional video system. The second program corresponds to a condition wherein a code is already set up, in which case, the microcomputer provides control signals for erasing (muting) the audio and video signals to the appropriate output means, i.e. speaker and tube. As shown in Fig. 5, prompts are displayed on the screen (f, g). At the same time, on screen characters are displayed on the tube so that the user may perceive that the code is set up (3:24-31). At this point, the user operates the keyboard or remote control to input a code key signal, which corresponds to the claimed "secret code" or "code sequence" (3:31-32). When the inputted code key signal corresponds to the stored code key signal, the audio and video erasing signals are cut off and the video and audio are provided to the respective outputs (3:33-42). When the inputted code signal does not correspond to the stored code key signal, the process following the step for putting out audio and video erasing signals is carried out repeatedly (4:52-57). Additional embodiments for re-inputting a new code are also disclosed (Figs. 3C and 4). The process of inputting the code includes display of each character of the code sequence as it is entered into the system (Fig. 5) and immediately following entry of the last character as determined by the counter/register, it is determined whether or not the input key signal corresponds to the already set code N1 (4:41-45). If the input key signal corresponds to the stored code sequence, then the

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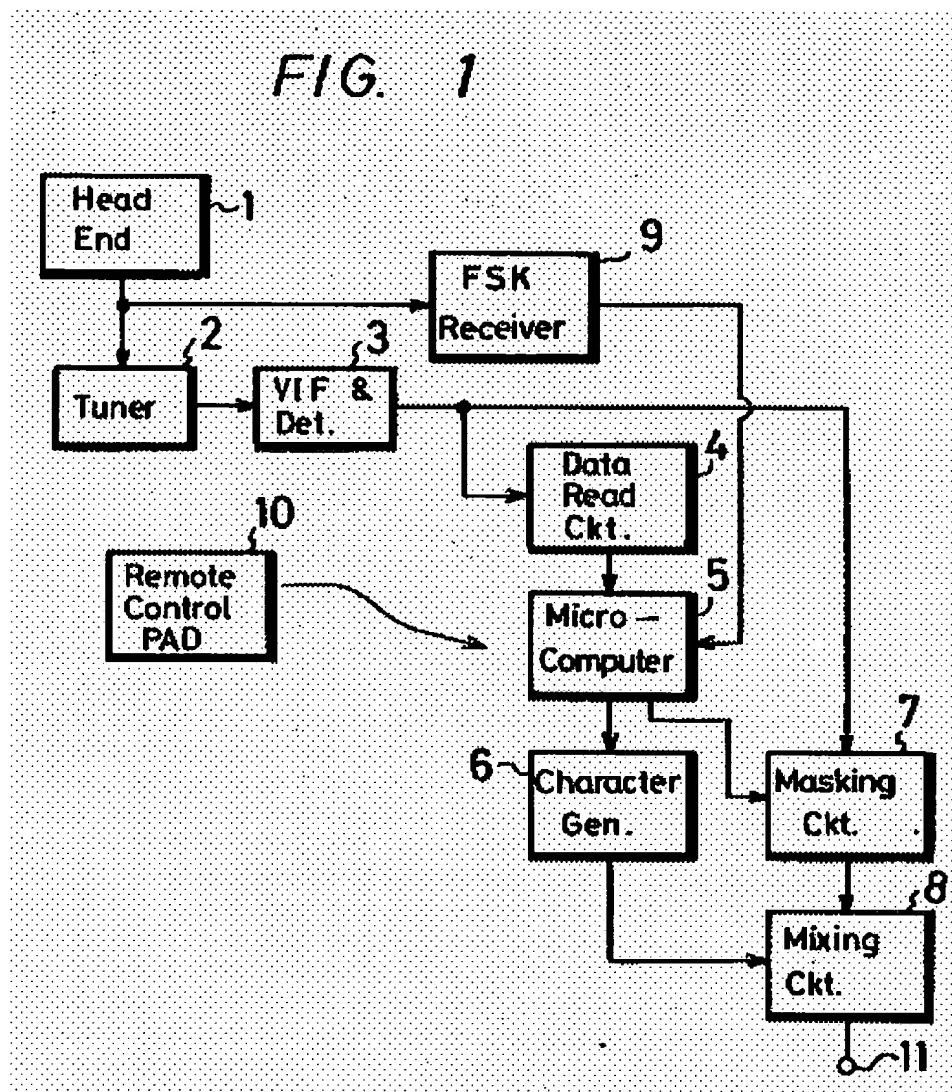
erasing signals are blocked and the television video and audio are provided in the normal manner (4:45-52). If the input key signal does not correspond to the already set code, the video and audio erasing signals are carried out repeatedly (4:52-57). Additionally, if the input key signal does not correspond to the already set code but is reinput, a new code is set. The driving element (6) of is driven only upon determination of the a match between the input code and the stored code. Thus, Rew teach checking for a key-data input from the keyboard or remote control unit during a system power standby mode of operation as well as displaying prompts on the screen for inputting a code sequence either for setting a locking function or enabling viewing, and thereby provides the claimed control to the video system.

14. Rew differs from the claimed invention since the switching element (63) is not "a mixer" in the conventional and disclosed sense of the word and since the switching element does not prevent a video signal from being output to a mixer.

15. Inagaki et al [REDACTED] also disclose a video system, having a normal and a standby mode of operation (as evidenced via the remote control turn-on operation of the system using button 10a), wherein video and audio may be muted from the video system

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in accordance with prescribed codes.



16. The system includes a microcomputer (5) responding to input signals from a remote control pad (10) for controlling the video images wherein in response to the remote control pad, the microcomputer provides a control output for a period of time defined by the input of a lock code and the input of an unlock code, a video signal processor (3), a character generating circuit (6) responding to information from the microprocessor, a mixing circuit (8) generating the video components (11) by mixing the video signal from the video processor (3) and the video signal from the character generating circuit (6), and a video masking circuit (7) responding to the control output for preventing the video signal from being output to the mixer. Muting of the sound is additionally provided during the blocking of the video.

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17. The masking circuit (7) and mixing circuit (8) provides a substantially equivalent function (erase/mute video/audio signals when locked) in a substantially equivalent environment (a video system in the form of a TV or CATV) for a substantially equivalent purpose (to provide control over viewable media) to the switching element of Rew.

18. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rew by substituting a conventional masking circuit/mixing circuit for the switching element in Rew as taught by Inagaki et al in order to effectively blank the video/audio signals from the output terminal of the video system and prevent viewing of programs considered harmful to certain viewers since the switching control and the masking/mixing circuits are substantially equivalent designs and since the masking/mixing circuit provides the advantage of the capability to simultaneously display video as well as on-screen character data, such as channel or time information, when both video and character data are available.

19. The combination of references wherein the masking/mixing circuit is substituted for the switching element is deemed to teach or suggest to the skilled artisan the claimed invention, including the following facets: providing a control signal via the application of key data followed by a code sequence using an on-screen character display (specifically, Rew); providing a control signal via the key data during a standby mode of operation (specifically Rew – power key signal input); a mixer mixing first video signal representative of the video program and second video data representative of on-screen character information (specifically, Inagaki et al); and muting circuits responsive to a control signal from the microcomputer for preventing audio outputs and preventing the first video signal from being output to a mixer (specifically Inagaki et al). Moreover, Rew teaches the use of a counter G to determine when the number of ciphers of the code corresponds to the number of ciphers of the stored code.

Claim Rejections - 35 USC § 112

20. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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21. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

22. Claims 44-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The original disclosure provides for receiving the lock key data only during a standby mode of operation. However, claims 44, 48, 55, and 56 set forth a process wherein a first lock key data signal is received and a second-lock key data signal is received, after the first lock key data signal, such receiving times being separated by an interval including generating an image formed by mixing a video signal and a character signal and displaying such image signal on a screen. Since the lock key data is only utilized when in standby (system power-off flag, see step 200/201 of Figure 3A), the receiving of a second lock key data signal after receiving said first lock key data signal is not sufficiently disclosed. Furthermore, if the routine is run only when the system is in a standby mode of operation, it is unclear how video is generated or displayed.

23. Claims 44-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 44, 48, 55 and 56 are insufficiently disclosed in the specification as originally filed.

Applicant has claimed priority in the US patent to prior applications 07/681,843 (1990) and 07/398,927 (1989) and concomitantly to foreign application Korea 88-18099 (1988). In an amendment (3/1993) in 08/024,495, the applicant added claims 2-7. Claim 5 of that amendment added a limitation of generating first and second control outputs for a period of time defined by a first input of a lock key followed by a secret code and a second input of lock key data followed by said secret code. The specification does not provide an enabling disclosure for such limitation particularly in light of the fact that in each instance of receiving a lock key data signal, video is reproduced or received and displayed; thus it is not in a standby

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mode as required by the original specification, i.e. the routine is not run unless step 200 responds with a "Y". Moreover, it is unclear what represents a locked state going to an unlocked state, an unlocked state going to a locked state, or a locked state remaining in the locked state with respect to the claim language since in each case, a lock key data signal is received, video is reproduced or received and mixed with character data. Therefore, it is not clear how or where the original specification provides an enabling disclosure for receiving a first lock key data signal, generating a first character, and displaying a first image, and subsequently receiving a second lock key data, generating a second character signal, and displaying a second image before any determination of a match. Moreover, the amendment of 3/1993 appears to have improperly introduced new matter into the application.

Additionally, there is no support in the specification as originally filed for determining a match of first and second lock key data signals; there is nothing in the specification that equates the lock key data signal to the code sequence. In the specification, the lock key signal is differentiated from the digits of the code sequence representing the secret code. This problem exists in claims 44, 46, 50, and 52.

In claim 47, the locking of the audio and the unlocking of the video is insufficiently disclosed in the specification. The original specification describes the locking and unlocking of the audio/video together; it is not seen where in the specification the audio is locked while the video is unlocked.

In claims 50-52 and 58, the determination of whether the second lock key data is identical to a reference and the subsequent changing of the locking/unlocking state in dependence thereon is not adequately disclosed in the specification. There is nothing in the disclosure which provides an enabling disclosure as to what the reference is or how it may be used in any determination.

Claim 56 sets forth "generating . . . a mode change signal in response to said second lock-key data signal". It is not seen where this is disclosed in the original specification.

24. Claims 44-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 44, the language "locking said video signal and preventing application of said video signal to enable said mixing in dependence upon said determination" is indefinite and fails to clearly and distinctly set forth the invention. What is the difference between "locking said video signal" and

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"preventing application of said video signal"? The language "preventing application of said video signal to enable said mixing" is contradictory since the "preventing application of said video" and the "enabl(ing) said mixing" appear contradictory.

In claim 47, the language "locking said audio signal and releasing said muted video signal in dependence upon" the determination of whether a second lock key data signal is identical to a first lock key data signal is not clear since it is not understood why the audio would be locked and the video would be unlocked.

In claims 50-52 and 58, the determination of whether the second lock key data is identical to a reference and the subsequent changing of the locking/unlocking state in dependence thereon is not clear since the "reference" is undefined and not specified in the specification.

In claim 59, the language in lines 10-16 is not understood. In line 11, "a locked state" is defined as where the display system bars viewing of a video program. In lines 14-15, viewing of the video program is barred when the "display system is not in said locked state." Thus, the claim sets forth the barring of viewing of the video program when the display system is in both a locked and an unlocked state. Clarification is required as to why the video program is barred no matter what the state is, i.e. locked or unlocked.

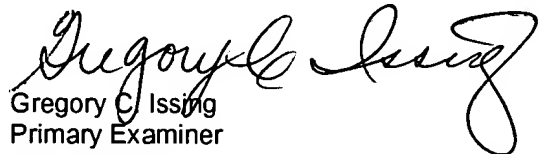
25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hayes (4,718,107) is cited for its teaching providing a mode key input followed by a code sequence in order to change states of the set-top converter among family viewing mode, enter access code mode, and parental control mode. Figures 9A and 9B show an algorithm for access control of video programming.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (571)-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

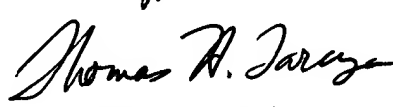
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)-272-6979. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gregory C. Issing
Primary Examiner
Art Unit 3662

gci

Reopening prosecution approved:

THOMAS H. TARCZA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600